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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/851,084 | 05/09/2001 | Normand Brisson | ODDY 001 | 6912 |

7590 10/02/2002
Isaac A. Angres
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Arlington, VA 22202

EXAMINER

COLLINS, CYNTHIA E

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 1638 | 2 |

DATE MAILED: 10/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/851,084

Applicant(s)

BRISSON ET AL.

Examiner

Cynthia Collins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-26 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

As the originally submitted claims did not include a claim number 11, Applicant should note that originally numbered claims 12-27 have been renumbered as claims 11-26, pursuant to 37 CFR § 1.126.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-6, drawn to a method of expressing PCA interacting partners in plant material, classified in class 435, subclass 468, for example.
- II. Claims 7-10, drawn to a system for use as a standard or control in a PCA assay or for use in validating a PCA assay, classified in class 435, subclass 4, for example.
- III. Claims 11-14, drawn to a plant transgenic for one or more genes, classified in class 800, subclass 298, for example.
- IV. Claim 15, drawn to a method of determining whether a mutated gene acts upstream in a pathway affecting an inducible interaction, classified in class 435, subclass 6, for example.
- V. Claim 16, drawn to a method of identifying one or more genes in a pathway controlling an inducible interaction which results in a monitorable activity, classified in class 800, subclass 276, for example.
- VI. Claim 17-21, drawn to a method of cloning a gene, a gene, a product, a vector and biological material, classified in class 536, subclass 23.6, for example.
- VII. Claims 22-23, drawn to a method and a plant, classified in class 435, subclass 440, for example.

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- VIII. Claim 24, drawn to a method of identifying a plant molecule that functions as a PCR interacting partner in a PCA assay, classified in class 435, subclass 7.1, for example.
- IX. Claim 25-26, drawn to a method employing a Protein Complementation assay/Universal Reporter system for detecting and screening for ligands and/or bioregulators of a plant cellular receptor, classified in class 435, subclass 455, for example.

For invention II above, restriction to one of inventions (A)-(C) is also required under 35 USC 121. Therefore, if Invention II is elected, Applicant must also elect one of inventions (A)-(C).

- (A) first and second protein-protein interaction domains of NPR1 + TGA2
- (B) first and second protein-protein interaction domains of FKBP + FRB,
- (C) first and second protein-protein interaction domains of leucine zippers

For invention III above, restriction to one of inventions (D)-(H) is also required under 35 USC 121. Therefore, if Invention III is elected, Applicant must also elect one of inventions (D)-(H).

- (D) leucine zipper/reporter molecule fusion interacting partners
- (E) NPR1/reporter molecule fusion interacting partners
- (F) TGA2/reporter molecule fusion interacting partners
- (G) FKBP/reporter molecule fusion interacting partners

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(H) FRB/reporter molecule fusion interacting partners

The inventions are distinct, each from the other because of the following reasons:

Inventions (A)-(H) are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions represent structurally different polypeptides. Therefore, where structural identity is required, such as for protein-protein interaction or enzymatic activity, the different polypeptides have different effects.

Inventions I-IX are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions different modes of operation, different functions, and different effects.

The system of Invention II is structurally and functionally distinct from the plants of Inventions III and VII, and from the gene, product, vector and biological material of Invention VI. The plants of Inventions III and VII are distinct plants because they comprise structurally and functionally distinct transgenes.

The methods of Inventions I and IV-IX are distinct methods because they require different method steps and have different end results. The method of Invention I requires transformation of plant material with a first construct and a second construct, followed by culturing and detecting, which is not required by the methods of Inventions IV-IX. The method of Invention IV requires performing a PCA assay followed by correlating a change, which is not

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required by the methods of Inventions I and V-IX. The method of Invention V requires mutagenizing a seed followed by germinating, treating, monitoring, and correlating, which is not required by the methods of Inventions I, IV and VI-IX. The method of Invention VI requires identifying a gene followed by cloning, which is not required by the methods of Inventions I, IV-V and VII-IX. The method of Invention VII requires mutating a plant or plant material followed by selecting, which is not required by the methods of Inventions I, IV-VI and VIII-IX. The method of Invention VIII requires reacting followed by correlating, which is not required by the methods of Inventions I, IV-VII and IX. The method of Invention IX requires generating a first nucleic acid followed by generating a first nucleic acid, transfecting and testing, which is not required by the methods of Inventions I and IV-VIII.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, their recognized divergent subject matter, and the requirement for different areas of search, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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Remarks

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Collins whose telephone number is (703) 605-1210. The examiner can normally be reached on Monday-Friday 8:45 AM -5:15 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on (703) 306-3218. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

CC
September 30, 2002

Phuong Bui
PHUONG T. BUI
PRIMARY EXAMINER 10/1/02